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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/683,542

10/10/2003

Carl M. Ellison

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09/22/2004

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EXAMINER

PEIKARI, BEHZAD

ART UNIT

PAPER NUMBER

2186

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/683,542

Applicant(s)

ELLISON ET AL.

Examiner

B. James Peikari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3/1/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 IDSs.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. With regard to the Information Disclosure Statement filed on August, 5, 2004, most of the references contained therein were repeated from a previously filed IDS in this application. Because of the burden on the examiner required to check each reference against each of the pages of each of the other IDSs, applicant is requested not to submit duplicate listings of prior art references.

### ***Drawings***

2. This application lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

### ***Specification***

3. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. On page 1, the related application information must be up dated, i.e., "now U.S. Patent No. 6,633,963 B1".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 37-76 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Browne, U.S. 6,272,533,

Claims 37-46 are directed to a processor that is able to operate in either a “normal” mode or in an “isolated execution” mode, wherein memory access is severely restricted. Note Browne’s “non-secure” mode and “secure” mode, respectively (note the Abstract or columns 4-6).

As for the “multi-memory zone access checking circuit”, this is simply the mechanism that checks whether or not a requested access is directed to a currently active physical address (of a memory area) that is prohibited. The grant of access is permitted or denied based on the result of this detection. Note Figure 5. In Browne, this is taught by the switch that “selectively enables and disables transmission” (note column 5).

As for the "execution mode word" which may be asserted as a signal when in the isolated execution mode, note that one embodiment in Browne allows the switch to be operated automatically by a second processor (note column 6) such that the signal to operate in secure (isolation) mode comes from a command (word) from the second processor. The flexible design of the Browne system allows for protection of all kinds of data or instruction code including various nubs, operating system code, private data, etc.

As for claims 47-76, these are rejected for the reasons corresponding to claims 37-46 above.

6. Claims 37-76 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Barnett, U.S. 6,292,874.

Claims 37-46 are directed to a processor that is able to operate in either a "normal" mode or in an "isolated execution" mode, wherein memory access is severely restricted. Note Barnett's "secure kernel" mode and "application" mode, respectively (note column 4).

As for the "multi-memory zone access checking circuit", this is simply the mechanism that checks whether or not a requested access is directed to a currently active physical address (of a memory area) that is prohibited. Flags and tables (note column 3) are used to determine whether a match for a grant or a denial of access will occur. In Barnett, this is taught by the use of limit registers to perform "memory address checking" (note the abstract or Figures 1 and 2).

As for the "execution mode word" which may be asserted as a signal when in the isolated execution mode, note that in Barnett, the claimed "execution mode word" is taught by a command from the memory management unit to the processing circuit to operate in the "application mode" (note the Abstract or Figures 1 and 3). The flexible design of the Barnett system allows for protection of all kinds of data or instruction code including various nubs, operating system code, private data, etc.

As for claims 47-76, these are rejected for the reasons corresponding to claims 37-46 above.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 37-76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,633,963. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because there is no feature of the present claims that cannot be found in claims 1-44 of the patent.

***Allowable Subject Matter***

9. Claims 37-76 would be allowable if the independent claims were amended to include language similar to the amendments made in the parent application on April 18, 2003 and if a terminal disclaimer were filed to overcome the double patenting rejection.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Peikari whose telephone number is (703) 305-3824.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached at (703) 305-3821.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 746-7239 (Official communications)

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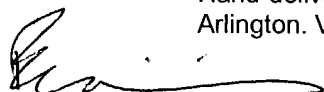
or:

(703) 746-7240 (for Informal or Draft communications)

or:

(703) 746-7238 (for After-Final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).



B. James Peikari  
Primary Examiner  
Art Unit 2186

September 19, 2004